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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,527	01/22/2004	Arnold P. Nerenberg	NERE-3817	5525

5409 7590 11/14/2006

SCHMEISER, OLSEN & WATTS  
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SUITE 302  
LATHAM, NY 12110

EXAMINER
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OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/767,527	NERENBERG, ARNOLD P.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-9, 11, 13-15, 21-29, 31, and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by CHECKBOOK (“Health Clubs,” Washington Consumers’ CHECKBOOK, Volume 12, Fall 2001 / Winter 2002, Reprint provided by Applicant in IDS submitted 1/22/04).**
3. As per **independent Claims 1 and 21**, CHECKBOOK discloses a method (system) for assessing a physical exercise facility, comprising the steps of: inspecting the facility by at least one inspector [inspection team] (pgs.1 and 13, surveyed customers) through at least one on-site inspection of the facility by the at least one inspector (survey answers are based on customer experience at Health Club – equivalent to inspection); and [an organization] rating the facility (pg.13, CHECKBOOK aggregates and interprets the customer and additional source data) using a plurality of rating factors derived from the at least one on-site inspection (Pgs. 4-13).
4. As per Claims 2 and 22, CHECKBOOK discloses wherein the rating factors include comradery experienced by users of the facility (pg.4, friendliness rating).

5. As per Claims 3 and 23, CHECKBOOK discloses wherein the rating factors include healthfulness of the environment of the facility (pg.4, Cleanliness), competence of trainers utilized by the facility for assisting and guiding the users (pg.4, Quality of instructors), and quality, quantity, variety of exercise equipment available to the users (pg.4, Adequacy of facilities/equipment for demand; pg.6).
6. As per Claims 4 and 24, CHECKBOOK discloses wherein the rating factors include availability of products and services supplied by the facility for use by the users in support of at least one of exercise and health goals of the users (pg.4, Adequacy of facilities/equipment for demand; pg.6).
7. As per Claims 5 and 25, CHECKBOOK discloses wherein the rating step includes generating an overall rating for the facility, and wherein the overall rating is a function of the rating factors (pg.4, CHECKBOOK top rating designation).
8. As per Claims 6 and 26, CHECKBOOK discloses publishing the overall rating (results available through CHECKBOOK Publications).
9. As per Claims 7 and 27, CHECKBOOK discloses publishing the rating factors (results available through CHECKBOOK Publications).
10. As per Claims 8 and 28, CHECKBOOK discloses wherein publishing the overall rating includes publishing the overall rating on an Internet website (results available through CHECKBOOK Publications website, [www.checkbook.org](http://www.checkbook.org)).
11. As per Claims 9 and 29, CHECKBOOK discloses wherein the Internet website is owned or controlled by an organization that performs the rating step (CHECKBOOK Publications website, [www.checkbook.org](http://www.checkbook.org)).

12. As per Claims 11 and 31, CHECKBOOK discloses wherein the overall rating is a weighted arithmetic average of the rating factors (pg.13, Top Ratings determined through a weighted scoring system).
13. As per Claims 13 and 33, CHECKBOOK discloses wherein the at least one on-site inspection consists of a plurality of on-site inspections (pgs.4 and 5, number of ratings).
14. As per Claims 14 and 34, CHECKBOOK discloses wherein the at least one on-site inspection includes an unscheduled inspection by the at least one inspector (pg.13, surveys are based on unscheduled unannounced visits to the health club).
15. As per Claims 15 and 35, CHECKBOOK discloses wherein the at least one inspector consists of a plurality of inspectors (pgs. 1 and 13, surveyors).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
17. **Claims 10, 12, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHECKBOOK.**
18. As per Claims 10 and 30, CHECKBOOK fails to expressly disclose wherein the overall rating is an unweighted arithmetic average of the rating factors.

19. However, CHECKBOOK does disclose generating an overall rating of a Health Club through the use of subjectively weighted scoring system (pg.13, Top ratings), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set all weightings as equal, which would be equivalent to no weighting system.
20. As per Claims 12 and 32, CHECKBOOK fails to expressly disclose wherein the rating factors include comradery experienced by users of the facility, and wherein said comradery has a higher weight than any other rating factor utilized for generating said overall rating.
21. However, CHECKBOOK does disclose tracking the Friendliness of a Health Club (pg.4), and generating an overall rating of a Health Club through the use of subjectively weighted scoring system (pg.13, Top ratings), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the weighting based on user preferences (pg.13, top rating, apply your own subjective judgments).
22. **Claims 16 and 36 are rejected under 35 U.S.C. 103 as being unpatentable over CHECKBOOK.**
23. As per Claims 16 and 36, CHECKBOOK does not expressly show wherein the plurality of inspectors includes a male inspector and a female inspector.
24. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The facility assessment method/system would be performed regardless of the demographics of the inspector. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a variety of inspector demographics, to include a male inspector and a female inspector, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
26. **Claims 17-20 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over CHECKBOOK in view of McLuhan, (McLuhan, Robert, “Brands put service under the spotlight: Companies are enlisting mystery shoppers to test the quality of their offering,” Marketing, February 21, 2002).**
27. As per Claims 17-20 and 37-40, CHECKBOOK fails to expressly disclose training and/or qualifying inspectors who are to perform said inspecting.
28. However, McLuhan discloses the use of “mystery shoppers” for completing a detailed evaluation of a service establishment, to include Health Clubs. McLuhan also discloses the training of the operatives prior to completing the mystery shopping (pg.1, gives set points to look for).
29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included training and/or qualifying inspectors who are to perform said inspecting, as disclosed by McLuhan in the system disclosed by CHECKBOOK, for the advantage of providing a method/system of assessing a facility,

with the ability to ensure effective and quality evaluations (assessments/inspections) by providing trained staff to complete the surveys.

*Response to Arguments*

30. Applicant's arguments filed 10/9/2006, with respect to Claims 1-40, have been considered but are not persuasive. The rejection will remain as FINAL based on the cited prior art.
31. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
32. As per the independent claims 1 and 21, the Applicant has made the argument that the cited prior art fails to teach or disclose wherein in an inspector (inspection team) inspects a facility and rates the facility based on the inspection.
33. However, Checkbook discloses wherein customers (equivalent to inspectors/inspection teams) are surveyed (plurality of rating factors) about a facility (pgs.1 and 13). The term inspecting and inspectors is a general action step/term that is completed by any customer that enters a facility, just by walking in the door, looking around and using the facility resources.



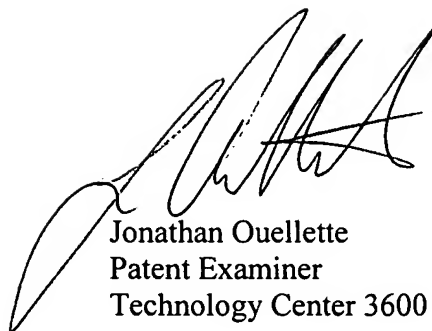
34. The Applicant has also stated that the prior art fails to include “comradery” as a rating factor.
35. Checkbook does disclose wherein “friendliness “ is used a factor for customer survey ratings. Friendliness refers to the customer/employee relationship that occurs while the customer is at the facility. The relationship can also be referred to as a form of “comradery” between the customers and the facility staff.
36. As per the remaining arguments made by the Applicant regarding the depend claims, the Applicant should refer to the rejections above, as the teachings of the cited prior art clearly teach equivalent terminology when rating a facility and publishing the results.

#### *Conclusion*

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
38. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
39. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

Art Unit: 3629

November 7, 2006



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